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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,160	08/10/2001	Manabu Yoshimura	33035M077	4910
441	7590	02/02/2004	EXAMINER	
SMITH, GAMBRELL & RUSSELL, LLP 1850 M STREET, N.W., SUITE 800 WASHINGTON, DC 20036			LIN, TINA M	
			ART UNIT	PAPER NUMBER
			2874	

DATE MAILED: 02/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/913,160	YOSHIMURA ET AL.	
	Examiner	Art Unit	
	Tina M Lin	2874	MW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1, 2, 4-6, 8-16 is/are allowed.
- 6) ☒ Claim(s) 3 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08 December 2003 has been entered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 3 and 17 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by U.S. Patent 5,841,942 to Mugiya et al. In regards to claim 3, Mugiya et al. discloses a semiconductor module with a mounting member (13a), a first tubular member (14) where the first member is arranged on the mounting member, an optical semiconductor element (12) arranged in the first member, a second tubular member (16) arranged on the opposite end of the first member, an optical fiber (19) coupled to the optical semiconductor element and where the optical fiber extends in the second member, and a third tubular member (20) with a pair of openings for the optical fiber and which also accommodates the second member and ferrule (18). (Figure 3A) In regards to claim 17, Mugiya et al. discloses a semiconductor module with a mounting member (13a), an optical semiconductor element (12) supported by the mounting member, a first tubular member (14) with the first member in communication with the mounting member and a second

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tubular member (16) mounted on the other end of the first member. (Figure 3A) Mugiya et al. further shows in Figure 3A-1 a magnified portion of the mounting member and the first tubular portion. From the magnified portion, it can be observed that the first tubular portion (14) has a smaller diameter than the mounting member (reference number not labeled in magnified figure).

Allowable Subject Matter

Claims 1, 2, 4-6 and 8-16 are allowed. The prior art of record in this application fails to disclose or reasonably suggest an optical semiconductor module with all the structural limitations of claim 1. Specifically, the prior art of record in this application fails to disclose a lens held by the first member between the semiconductor element and the optical fiber. Furthermore, if the lens were to be moved in order to allow for the first member to secure it, there would be a structural difference. The closest prior art of record is U.S. Patent 5,127,074 to Watanabe et al. In Figure 1, Watanabe et al. teaches an optical semiconductor module comprising a mounting member with an element mounting surface and contact surface, a first tubular member, a second tubular member, an optical semiconductor element, and an optical waveguide optically coupled to the semiconductor element. Additionally, it can be observed from Figure 1, a third member having an opening for the optical fiber to extend through the first and second end faces of the ferrule. Furthermore, Watanabe et al. teaches an optical semiconductor module with a lens between a waveguide and semiconductor element and where this semiconductor element is a light emitting element. Finally, Watanabe et al. teaches an annular connecting portion to surround the optical axis of the optical semiconductor element. But Watanabe et al. fails to disclose the outer edge of a first portion to be located inside the edge of the mounting member. Watanabe et al. however does disclose of the first portion to line up with the edge of the

mounting member. Watanabe further fails to disclose a lens held by the first member between the semiconductor element and the optical fiber. Therefore, Claims 1, 2, 4-6, and 8-16 are allowed.

In regards to claims 1, 2, 4-6 and 8-16, Applicant's arguments filed 08 December 2003 have been fully considered and are persuasive.

With respect to claims 3 and 17, Applicant's arguments filed 08 December 2003 have been fully considered but they are not persuasive. In regards to claim 3, Applicant argues the third member of the claim is patentably distinct from the cited prior art because the third tubular member has a pair of openings and accommodates the second member and ferrule. However, Mugiya et al. does disclose these features as discussed above. In regards to claim 17, Applicant argues the first end portion of the first member to have a smaller diameter than the mounting member. Applicant further refers to Figure 3A to show the first member having a larger diameter than the mounting member. However, Mugiya et al. shows a magnified view of the junction in figure 3A-1. This Figure shows that the first member to have a smaller diameter than the mounting member.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. References A-C discuss different configurations of optical semiconductor modules with at least two tubular members.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

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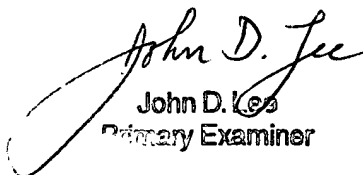
the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tina M Lin whose telephone number is (703) 305-1959. The examiner can normally be reached on Monday-Friday 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rodney Bovernick can be reached on (703) 308-4819. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.


TML


John D. Lee
Primary Examiner